

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 15, 2007. The Examiner is thanked for the thorough examination of the present application. Applicants have carefully studied the outstanding Official Action. The present response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Upon entry of this response, claims 1-30 are pending in the present application. Claims 1-30 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over unpatentable over Hartman *et al* (U.S. Pat No 7,146,031, hereinafter "Hartman") in view of Katakura (U.S. Pat No. 5,953,500). Applicants respectfully request consideration of the following remarks contained herein. Claims 7-11, 18-22 and 28-30 have been cancelled without prejudice. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Response to Claim Rejections Under 35 U.S.C. § 103

Claims 1-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over unpatentable over Hartman in view of Katakura. For at least the reasons set forth below, Applicants traverse these rejections.

First, Applicants believe that the rejection based on the combination of Hartman in view of Katakura is not sustainable as the former neither teaches nor suggests a motivation for its combination with the latter. Only a hindsight argument leads to such a combination. The primary purpose of the Hartman disclosure is to properly order and orient a series of mammograms while keeping them grouped by patient. The primary purpose of Katakura is to

print out digital images. There is no *a priori* motivation to combine the two references as nowhere in Hartman (as indicated in FIGS. 1-5 of the Hartman reference and as discussed below) is there a teaching or suggestion of a printer or the desirability of a printout of film mammograms, the latter films being entirely absent in the Katakura disclosure.

Independent Claims 1 and 12 are Patentable Over Hartman in View of Katakura

Independent claims 1 and 12 have been amended to include the following feature: "*inputting patient identification data for a series of N patients, where N≥1, using an inputting device, the identification data stored in a memory of a processor.*" These amendments are supported *inter alia* by original claims 7 and 25. The amendment is also *inter alia* supported by FIG. 4D and discussion therewith. Applicants respectfully submit that the amendments to claims 1 and 12 (and 2 and 13) are made to improve clarity and or to provide sufficient antecedent basis. Applicants submit that no new matter is added by the amendments.

Applicants respectfully submit that the feature above is neither taught nor suggested by Hartman or the combination of Hartman and Katakura, as identification data is input by other means. For example, in the Hartman reference, identification data is input by positioning patient identification bar codes on the separator films. The Office Action rejected claim 7 as being taught *inter alia* by FIG. 10 of the Hartman reference and related text where identifier data is provided by the identifier label on the separator sheet. Claim 1, as amended, now explicitly requires the inputting of patient identifier data using an input device as taught in original claims 7 and 25 and not through data affixed to a film as taught by the Hartman reference.

The amendment to claims 1 and 12 recite: "***the separator film allow for associating . . . film mammogram between each of two nearest separator films in sequential fashion with the inputted identification data . . .***" Applicants submit that this amendment is supported *inter alia* by page 11, lines 12-14 and page 10, line 30 to page 11, line 11. It should be noted that this feature is absent in the Hartman and Katakura references when these citations are taken individually or together. Finally, Applicants would like to note that the relevance of the cited text from the Hartman reference (column 5, lines 24-36 on the bottom of page 2 and on page 3) with regard to claim 1 is unclear.

Additionally, the inclusion of the words "two nearest" in claim 12 is supported *inter alia* on page 20, lines 16-17. The inclusion of the word "physical" in claim 12 is supported *inter alia* on page 11, line 9.

Accordingly, Applicants respectfully submit that independent claims 1 and 12 patentably define over the combination of Hartman and Katakura for at least the reason that the combination fails to disclose, teach or suggest certain features in claims 1 and 12.

Independent Claim 23 is Patentable Over Hartman in View of Katakura

Independent claim 23 is rejected in the Office Action based on several citations from Hartman or Hartman in view of Katakura. The amendments to claim 23 are minor changes to improve clarity and/or to agree better with antecedents and/or can be found elsewhere in the original claims or specification. Applicants submit that claim 23 is patentable over the combination of Hartman and Katakura as nowhere in these two references is there a teaching or a suggestion of a "***means for synchronizing said scanner and said printer such that the printout of the scanned films of a patient is laid on the scanned film mammograms prior***

to the delivery to said collating station of said separator film," as recited in claim 23. That is, the combination fails to teach of a means for synchronizing the printing out of a printout so that the printout can be conveyed and collated with its associated set of film mammograms. Such means for synchronization is unnecessary in Katakura as the reference refers only to digital images without any discussion of analogue film sources. Furthermore, such means for synchronization is unnecessary in Hartman where analogue film sources are present but no printer and printout is discussed. Since all elements or limitations must be taught or suggested in the references cited when the references are taken individually or together and such is not the case here, Applicants believe that the §103 rejection of claim 23 is unsupportable and the claim is allowable.

Dependent Claims 2-6, 13-17, and 24-27 are Patentable

Applicants submit that dependent claims 2-6, 13-17, and 24-27 are allowable for at least the reason that these claims depend from an allowable independent claim.

See, e.g., In re Fine, 837 F. 2d 1071 (Fed. Cir. 1988).

As independent bases for patentability, Applicants submit the following additional reasons below. Claim 2 has been rejected based on a reading of Katakura indicating a printing out of information from a digital image. Claim 2, as amended, does not relate to a printout *per se*, but to the printing out of digitized images of film mammograms, the printout of which is synchronized, conveyed and collated together with the set of film mammograms to which the printout relates providing a collated package of physical data. The claim has been amended to better emphasize this point. A printout alone as taught by Katakura would be insufficient as collating, conveying and retaining the printout together with its associated film

mammograms is required in the claim. Nowhere is such collating indicated either by Katakura individually, or by Katakura and Hartman if taken together. Moreover, since Katakura addresses only digital images to the total exclusion of analogue films, these teachings are incapable of indicating synchronized collation of analogue films and associated printout to form a collated package of physical data within the recitations of Applicant's amended claim 2. Amended claim 2 should therefore be allowable.

Claim 3 requires that the printout itself include location markers of processor-detected anatomical abnormalities. The claim has been rejected on the basis of Hartman column 8, lines 31 and 60 and the remarks indicated in the rejection of claim 2. As noted above with respect to claim 2, Hartman does not discuss a printout and does not even mention a printer while Katakura does not require the printout being conveyed and collated together with a set of film mammograms, such films being absent in Katakura. Importantly, the markers cited in the rejection and discussed in the rejection as being found in Hartman are physical lead (Pb) markers which are physically appended to the film and which indicate the films' order and orientation; they are not location markers printed on the printout indicating processor-detected anatomical abnormalities. Nowhere in Katakura or Katakura together with Hartman is there mention of a printout having location markers of processor-detected anatomical abnormalities and claim 3 should be allowable.

With regard to claim 3, the Applicants wish to note that the notation on page 3 of the Office Action relating to detecting anatomical abnormalities by the processor is not at issue. It should be borne in mind that Hartman discusses detecting and presenting processor determined abnormalities on the computer displayed digital image. The abnormalities discussed in claim 3, on the other hand, are for presentation on printouts for storage with a

collated set of analogue films. There are no such printouts in Hartman. Applicants submit that the amendments to claims 2 and 13 are supported as follows:

- "the printout falls onto ... mammograms ..." is supported *inter alia* on page 11, lines 6-7 and page 12, lines 3-5;
- "the printout and its associated ...mammograms form a collated package of physical data ..." is supported *inter alia* on page 11, lines 9-10;
- the synchronization of the steps of printing and conveying is supported *inter alia* on page 17, lines 12-20.

The addition of the word "together" in claim 13 is suggested *inter alia* on page 17, line 15.

The other changes to claims 1 and 12 (and 2 and 13) are to improve clarity and or to agree with antecedents. The Applicants believe that no new matter has been added

The addition of "detected by the processor" in claims 3 and 14 is *inter alia* supported by page 16, line 1.

Applicants submit that the arguments above relating to claims 2 and 3 apply *mutatis mutandis* to claims 13 and 14 as well. For these reasons, as well as for the reasons noted above, claims 2-6, 13-17 and 24-27 all being directly or indirectly dependent from one of claims 1, 12, 23, 2, and 13 now allowable are themselves deemed to be allowable.

V. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

Applicants respectfully submit that all pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



Scott A. Horstemeyer
Registration No. 34,183

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**
100 Galleria Parkway NW
Suite 1750
Atlanta, Georgia 30339
(770) 933-9500